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EXAMINER

WOLLSCHLAGER, JEFFREY MICHAEL

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/500,713  
Filing Date: July 06, 2004  
Appellant(s): MEERMAN ET AL.

Mr. William P. Berridge and Mr. Jeffrey R. Bousquet  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed October 26, 2009 appealing from the Office action mailed December 29, 2008.

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**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 1-7 are pending and rejected.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the

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appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

#### **(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

#### **(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The amendment to the drawings filed April 30, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Figure 2 has been modified to show the plates and the slot or diaphragm at the bottom of the coagulation bath. This objection may be overcome by pointing to the location in the original disclosure where support for this amendment may be found. Otherwise, applicant is required to cancel the new matter in the reply to this Office Action.

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Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 1 and 2, the limitation “wherein the slot or diaphragm is positioned at the bottom of the coagulation bath”, as shown in replacement Figure 2 filed April 30, 2007, does not appear to be supported by the original disclosure. Claims 3-7 are rejected as dependent claims. This rejection may be overcome by pointing to the location in the original disclosure where support for this limitation may be found.

#### **(10) Response to Argument**

Appellant essentially alleges that the examiner has improperly rejected the claims under 35 U.S.C. 112, first paragraph and has improperly objected to amended Figure 2 under 35 U.S.C. 132(a) since the specification reasonably conveys to those skilled in the art that the inventors were in possession of the claimed invention as of the date of invention.

Essentially, appellant's arguments attempt to mine “implicit support” (appellant's characterization) to support the configuration shown in amended Figure 2 (replacement sheet filed April 30, 2007) and set forth in the claims while characterizing a more direct statement within the specification as an “internal inconsistency” (appellant's characterization). The examiner disagrees with the arguments and maintains the position that the claims fail to comply with the written description requirement and that the objection to amended Figure 2 is proper.

As an initial matter, the examiner notes that specific point of contention revolves around whether the “slot or diaphragm” (5) and a disclosed discharge opening at the bottom of the coagulation bath correspond to each other. The examiner submits that the specification does

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not reasonably convey such a relationship between the "slot or diaphragm" and the discharge opening. Accordingly, the examiner submits that there is insufficient support in the original disclosure for the limitation that "the slot or diaphragm is positioned at the bottom of the coagulation bath" (last 2 lines of claims 1 and 2) and as shown in amended Figure 2.

Also as an initial matter, the examiner notes that the original drawings filed on July 6, 2004 in no way show or suggest such a corresponding relationship. For example, original Figures 2 and 4-6 show or suggest the "slot or diaphragm" at a position other than the bottom of the coagulation bath. Further, while the examiner does not disagree that the original disclosure provides support for providing a discharge opening at the bottom of the coagulation bath (even though such an opening is not shown in the original Figures), it is the examiner's position that such a disclosure of a discharge opening does not of itself provide the necessary evidence to reach the conclusion that the discharge opening and the "slot or diaphragm" correspond to each other such that the specification reasonably conveys the relationship shown in amended Figure 2 and as set forth in claims 1-7.

A. Appellant argues that the background of the invention helps establish the standpoint of one of skill in the art at the time the application was filed.

On pages 27-28 of the brief, appellant argues that the "present invention" is an adaptation of the Meerman reference cited in the disclosure and is a "very simple" embodiment that achieves substantial improvement over Meerman. The argument is not persuasive.

The examiner submits, for the sake of completeness, that the arguments set forth on pages 27-28 of the brief under section A do not directly address the point of contention and don't advance a position that the "slot or diaphragm" and the discharge opening at the bottom of the coagulation bath correspond to each other.

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B. Appellant argues that there are five instances where the specification provides implicit support for the slot or diaphragm being located at the bottom of the coagulation bath.

1. Appellant points to paragraph [0006] of the published application (note: all citations in this examiner's answer and the brief are to the published application) and argues that the "the geometry of the present invention" and "the geometry of the coagulation bath's bottom" are specifically related, noting that the word "particularly" links the two sentences in which the phrases are employed. Accordingly, appellant argues that the feature of the present invention that relates to the geometry of the coagulation bath's bottom must be either the slot/diaphragm or the spinning field and that since it is clearly not the spinning field it is the slot/diaphragm. This argument is not persuasive. The examiner submits that this attempt to link the slot/diaphragm to the coagulation bath bottom is not persuasive in view of a straightforward reading of the specification.

The examiner notes that the two sentences in paragraph [0006] are in the background of the invention section and that the second word in the first sentence is "was". In context, the "was", regarding the "geometry of the coagulation bath's bottom", seems to be pointing back to the configuration in EP 0,904,431 (Meerman) described in paragraph [0005] that "the edges of adjacent openings are at different heights". Accordingly, the disclosure is pointing to the heights of adjacent openings in the bottom of the coagulation bath and is not directly pertinent to point of contention regarding a corresponding location of the slot/diaphragm and the discharge opening at the bottom of the bath.

The disclosure in paragraph [0006] of the "geometry of the present invention" (i.e. the location of plates (7a) and (7b)) is understood, for example, in view of original Figure 2, to be applicable to the configuration wherein adjacent openings are at different heights. However,

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this in no way establishes as a necessity or even implication that the slot/diaphragm and the discharge opening at the bottom correspond to each other as shown in amended Figure 2.

2. Appellant argues that the only antecedent basis for "the slot or diaphragm" described in paragraph [0007] is the discharge opening discussed in paragraphs [0005] and [0006] and that accordingly the slot or diaphragm corresponds to the discharge opening and is therefore located at the bottom of the coagulation bath.

This argument is not persuasive. The examiner notes that the premise of the argument seems to assume that since the first time the phrase "slot or diaphragm" is employed in the specification it is preceded with the word "the" instead of "a" that it clearly must be referring back to what appellant wants the examiner to conclude it must be referring. In other words, the examiner submits the argument is somewhat circular in its logic and assumes the desired conclusion at its outset. Further, while the arguments in the brief suggest an "internal inconsistency" (appellant's characterization) be interpreted differently than what the words appear to mean on their face (to be discussed later in this examiner's answer), the argument here suggest applying an over-weighted interpretation to an antecedent basis issue.

Further still, the examiner submits that it seems more likely in view of the original disclosure that the "the" of "the slot or diaphragm" in paragraph [0007] was employed in the original because the phrase "the geometry of the present invention" had been previously employed in paragraph [0006] thereby implicitly disclosing "the slot or diaphragm" shown, for example, in the original figures. In other words, the examiner submits the antecedent issue (to the extent it is an "issue") is reasonably understood within the purview of the original disclosure and that it is not necessarily or even implicitly directive towards the configuration shown in amended Figure 2.



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3. Appellant argues that the terms "opening" and "slot or diaphragm" are used interchangeably in paragraph [0018].

Appellant argues that the cited statement in paragraph [0018] only makes sense if the "slot or diaphragm" is the same as the "opening at the bottom of the coagulation bath" and further points to such an attestation from Dr. Picken. This argument is not persuasive. The examiner submits again that the argument appears to start with the intended conclusion at the outset and that a plain reading of the paragraph seems to merely suggest that the outlet of the bottom of the coagulation path must be properly sized in order to ensure the material is not damaged by scraping the edges of the plates (7a) or (7b) which form the slot or diaphragm (5). For example, if the outlet at the bottom of the coagulation path were to be too wide, the filaments would naturally begin to spread apart and the upstream width of the filament bundles would also begin to spread apart, eventually reaching a point where they would begin to scrape the plates (7a) and/or (7b). The examiner submits that the original disclosure makes sense as it was originally disclosed and that it does not by necessity or implication require or suggest the "opening" and the "slot or diaphragm" are the same. The examiner submits that such a conclusion can only be reached by starting with the argued configuration in mind at the outset of the analysis.

4. Appellant argues that paragraphs [0009] and [0011] teach that the discharge opening corresponds to the slot/diaphragm depicted in Figure 6.

Appellant argues that implicit to the discussion of the coagulant stream flow directions in paragraphs [0009-0011] is that the slot/diaphragm is located at the bottom of the bath. This argument is not persuasive. The examiner agrees that Meerman cited in paragraph [0005] is described as having adjacent openings at different heights. However, this does not teach or suggest that the adjacent openings of different heights correspond to the slot/diaphragm. Said

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differently, merely because the plates (7a) and (7b), which form the slot/diaphragm (5), are at different heights (see original Figure 2) and adjacent openings at the bottom of the coagulation bath are at different heights (as described in paragraph [0005]) this does not reasonably convey that the slot/diaphragm and the discharge opening correspond with each other.

5. Appellant argues that paragraph [0033] teaches that the spinning device can be closed by covering the slot or diaphragm and that only way the bath could be closed in this manner is if the discharge opening and the slot/diaphragm are the same.

This argument is not persuasive. The examiner submits that in the context of the original disclosure the description of closing the spinning device by placing a covering plate just above slot or diaphragm is most reasonably understood to suggest placing a plate on top of the bath. It is noted that the slot/diaphragm is located, for example, 10 mm below the surface of the coagulation bath (paragraph [0039]) and that the space between the spinning field (2) and the surface of the bath is 6 mm (paragraph [0038]). In context, the examiner submits closing the spinning device by placing a covering plate just above the slot or diaphragm suggests placing the covering plate below the spinning device and above the slot or diaphragm somewhere within the described 16 mm of space (i.e. 10 mm + 6 mm). For example, in context, the disclosure more likely seems to suggest placing the plate immediately above the liquid surface of the bath (i.e. slightly more than 10 mm above the slot/diaphragm,) and below the spinning field. The examiner again submits that a more straightforward interpretation of the disclosure than that which has been argued makes sense. Further, the examiner submits that other plate configurations could be employed that do not necessarily or implicitly require the argued configuration. For example, a plate with extension legs could be utilized that not only covers the diaphragm/slot, but that also extends down to cover the outlet at the discharge opening. The

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examiner submits that the disclosure of the covering plate does not reasonably convey the argued configuration.

C. Appellant argues that the examiner's position regarding paragraphs [0029] and [0018] requires the examiner to improperly apply an "absolute certainty" standard instead of the appropriate "reasonable clarity" standard.

This argument is not persuasive. As an initial matter, the examiner submits that the five instances appellant has argued in section B to provide implicit support for the argued configuration do not reasonably convey possession of the configuration set forth in the claims or in amended Figure 2. It is submitted that the examiner has provided clear and reasonable interpretations of the original disclosure that do not suggest or require the argued configuration. Even further, it is submitted that the interpretations set forth by the examiner regarding the citations that are intended to implicitly support the argued configuration make as much sense or more sense than the interpretations argued in the brief. As such, at the outset, the examiner submits he is not employing an "absolute certainty" standard at all and that what is "reasonably conveyed" by the original disclosure is something different than that which is shown in amended Figure 2 and set forth in the claims.

From this starting point (i.e. no reasonably conveyed possession of the argued configuration), the examiner further looks at paragraphs [0018] and [0029] and submits that these paragraphs further support the position set forth in the rejection.

Paragraph [0018], in part, states:

"To further reduce convergence in the filament bundle or filament bundles it is preferred to provide the bottom of the coagulation bath per spinning field with an opening, the projection of which preferably has a similar shape and is somewhat narrower in width than the projection of the spinning field." (Emphasis added).

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Paragraph [0029], in part, states:

"In all embodiments, each of the spinning fields 2 is in combination with a slot or diaphragm 5." (Emphasis added).

As such, the examiner submits that a plain reading of the cited sentences from paragraphs [0018] and [0029] suggests that while a discharge opening at the bottom of the bath for each spinning field is only "preferred", it is necessary (i.e. "in all embodiments") for each spinning field to have a slot or diaphragm. Accordingly, it follows that the discharge opening and the slot/diaphragm do not necessarily or implicitly correspond to each other since one is "preferred" while the other is necessary for the practice of the invention.

Further, the examiner agrees that these sentences in paragraphs [0018] and [0029], like all others sentences, are theoretically open to different interpretations (i.e. it does not establish beyond ALL uncertainty as appellant points out on page 35 of the brief). However, it is submitted that the interpretation provided by the examiner is the most straightforward and that it is more reasonable than the "internal inconsistency" argument set forth (appellant's characterization of these cited portions of the specification). It is submitted by the examiner that this "internal inconsistency" (appellant's characterization) shown by the juxtaposition of these sentences in paragraphs [0018] and [0029] supports the position set forth in the rejection and that the argued configuration is not reasonably conveyed in amended Figure 2 and claims 1-7 to the extent required by the written description requirement.

In conclusion, the examiner submits that the most explicit evidence from the specification supports the rejection of the claims and the objection against amended Figure 2 and that the "implicit support" for the argued configuration is more reasonably interpreted in a manner which also supports the rejection and the objection.

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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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